

REMARKS

The Official Action mailed March 15, 2004, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

Claims 1-8 are pending in the present application, of which claims 1 and 2 are independent. Claims 1-8 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action asserts that the title is not descriptive (page 2, Paper No. 5). The Official Action does not provide a specific basis for the objection. As noted below, it appears that the Examiner may be concerned about the recitation of a method in claims 2-8. Therefore, in response, the Applicant has amended the title as follows: **DISK REPRODUCTION APPARATUS AND METHOD FOR USE IN SAME**. The Applicant respectfully submits that the new title is clearly indicative of the invention to which the claims are directed. Reconsideration of the objection is requested.

The Official Action objects to the drawings under 37 CFR § 1.83(a) asserting that the means recited in claim 1 is not shown in the drawings (page 2, Paper No. 5). The Applicant respectfully disagrees and traverses the assertion in the Official Action. The Applicant respectfully submits that Figures 1-6 and their corresponding descriptions in the specification show every feature of the invention specified in claim 1. For example, the program described in Figures 4-6 and in the specification at pages 11 and 12 includes several means for performing various functions including means for the functions recited in claim 1. Reconsideration of the objection is requested.

Paragraph 1 of the Official Action objects to claims 2-8 and notes that claim 2 recites a "disk reproducing apparatus" in the preamble but that claims 2-8 are written as method claims (page 2, Paper No. 5). In response, the Applicant has amended claim 2

to recite a method for use in a disk reproduction apparatus and claims 2-8 to recite the method. Reconsideration of the objection is requested.

Paragraph 2 of the Official Action rejects claims 2-4 under 35 U.S.C. § 112, first paragraph, asserting lack of enablement, that claim 2 "is a single step claim," and that claims 3 and 4 do not add an additional step (pages 2-3, Paper No. 5). In response, the Applicant has amended claims 2-4. Specifically, claim 2 has been amended to recite four distinct steps. Claim 3 further defines the last step in claim 2. Claim 4 further defines the last step in claim 2 or the step in claim 3. The Applicant respectfully submits that amended claims 2-4 recite multiple steps and are fully enabled by the specification and drawings. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

Paragraph 3 of the Official Action rejects claims 2, 5 and 8 under 35 U.S.C. §112, second paragraph, and asserts that claims 2, 5 and 8 are indefinite. In response, claims 2, 5 and 8 have been amended to better recite the features of the present invention and are believed to be definite as amended. Specifically, claim 2 has been amended to recite four distinct steps, claim 5 has been amended to recite "identified" instead of "know," and claim 8 has been amended to recite "that is used to register a program reproduction" instead of "for registration of program reproduction." The Applicant respectfully submits that amended claims 2, 5 and 8 are definite as amended. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

Paragraphs 6-10 of the Official Action reject claims 1-8 as obvious based on the combination of U.S. Patent No. 6,034,925 to Wehmeyer and U.S. Patent No. 6,131,129 to Ludtke et al., either alone or in combination with U.S. Patent No. 6,560,403 to Tanaka et al. and Official Notice. Specifically, paragraphs 6 and 8 reject independent claim 1 and dependent claims 3-6 as obvious based on the combination of Wehmeyer, Ludtke and Tanaka; paragraphs 7 and 10 reject independent claim 2 and dependent claim 8 as obvious based on the combination of Wehmeyer and Ludtke; and paragraph 9 of the

Official Action rejects dependent claim 7 as obvious based on the combination of Wehmeyer, Ladtke, Tanaka and Official Notice. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present invention, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claim 1 has been amended to recite that discrimination processing for a disk type is followed by discrimination processing for a sub-type of a disk discriminated as having a specific disk type and that the user is required to enter a group number in a distinct entering form corresponding to the discriminated sub-type. Independent claim 2 has been amended to recite that a disk type of a disk whose reproduction designation unit is designated by the user is identified and then a sub-type of the disk with the identified specific disk type

is identified, and that the user is required to enter data in a distinct entering form and a distinct input item order corresponding to the disk type and its sub-type. These features of amended independent claims 1 and 2 are supported, for example, by the embodiment described in the specification at page 10, line 27, to page 11, line 7, as follows:

Both DVD-Video and DVD-Audio have a two-layer hierarchical structure. Although the program reservation window shown in Fig. 1 may be used even if a disk corresponding to the disk number selected by a user is a DVD-Video. However, since the name of each level of DVD-Video is different from that of DVD-Audio, the program reservation window shown in Fig. 3 is used. A user can definitely confirm that the disk corresponding to the disk number selected by the user is a DVD-Video. It is also easy to make a user select Chapter. Chapter is a reproduction designation unit of DVD-Video.

In general, the present invention's disk reproduction apparatus serves a plurality of types of disk including a CD, a DVD-Audio, a DVD-Video and other optical disks having the same diameter as the CD and the like (as described at page 3, lines 9-13 in the specification). Also, for example, while the CD and the DVD are simply discriminated from each other in accordance with whether or not the disk has a two-layered hierarchical structure (*i.e.*, an upper layer called a group and a lower layer called a track) for storing tracks, a DVD-Audio and a DVD-Video both have a two-layered hierarchical structure and cannot necessarily be simply discriminated from each other. The present invention solves at least the above-identified problem.

In the present invention, a given disk whose track is designated by the user is identified in such a manner that a disk type of the given disk is first decided and then only when the decided disk type is a specific one (*e.g.*, DVD), a sub-type of the disk is further discriminated. Moreover, in the present invention, a predetermined control is performed so that, for the respective disks having the different disk types, the input item order is changed depending on the disk type, and, for the respective disks having the same disk type but different sub-types, the entering form is changed depending on the sub-type. Thus, the present invention identifies a disk designated by the user using two

steps of discrimination and causes the user to enter data in any one of distinct entering forms and any one of distinct input item orders.

Wehmeyer, Lutke, Tanaka and Official Notice, either alone or in combination, do not teach or suggest at least the above-referenced features of the present invention. Specifically, Wehmeyer, Lutke, Tanaka and Official Notice do not teach or suggest that discrimination processing for a disk type is followed by discrimination processing for a sub-type of a disk discriminated as having a specific disk type and that the user is required to enter a group number in a distinct entering form corresponding to the discriminated sub-type (claim 1) or that a disk type of a disk whose reproduction designation unit is designated by the user is identified and then a sub-type of the disk with the identified specific disk type is identified, and that the user is required to enter data in a distinct entering form and a distinct input item order corresponding to the disk type and its sub-type (claim 2).

Since Wehmeyer, Lutke, Tanaka and Official Notice do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Robert L. Pilaud
Reg. No. 53,470

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789